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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,049	07/21/2003	Gordon Allan	454313-2180.3	9983

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NEW YORK, NY 10151

EXAMINER

CHEN, STACY BROWN

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/624,049	ALLAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Stacy B. Chen	1648	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 42-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 and 30 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/161,092.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/21/03</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's preliminary amendment filed July 21, 2003 is acknowledged and entered.

This application has been transferred to Examiner Stacy Chen of Art Unit 1648. Claims 42-76 are pending and under examination.

#### ***Specification***

2. The specification (page 1, line 1) is objected to because the status of the related applications has not been updated to reflect the current status of those applications as US patents.

Drawing 7A is acknowledged and entered. The sequences in the drawings must be referred to by sequence identifiers, SEQ ID NO. The identifiers may be added to the specification's brief description of the drawings. Correction is required.

#### ***Claim Objections***

3. Claims 42-48, 51-62 and 74-76 objected to because of the following informalities:

- ❖ Claims 42-48, 51-62 and 74-76 are drawn to immunogenic compositions comprising an isolated porcine circovirus type II and an additional pathogen. It appears that Applicant intends for the immunogenic composition to be comprised of inactivated or attenuated viruses, as it is to be administered to pigs. Administering viruses that are not inactivated or not attenuated would not be suitable for administration. Clarification and/or correction is required.
- ❖ Claim 59 is objected to because the word spacing in line 3 is improper. Correction is required.

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- ❖ Claim 74 is objected to for the remarks cited in parentheses, which are unnecessary because the pathogens inherently cause the recited illnesses. Removal of the parentheses is required to overcome this objection.

***Petition to Correct Inventorship under 37 CFR 1.48(a)***

4. The papers filed July 21, 2003 for petition to correct inventorship are directed to the parent application, 09/161,092. This petition must be for the instant application.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 43-48, 53 and 74-76 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is apparent that cell line PK/15 and porcine circovirus type II (PCV2) viruses deposited under ECACC Accession Nos. V97100219, V97100217, V97100218, V98011608 and V98011609 are required to practice the claimed invention, respectively, because they are a necessary limitation for the success of the invention as stated in the claims. As a required element it must be known and readily available to the public or obtainable by a repeatable method set forth in the specification, or otherwise readily available to the public.

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If a deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the deposit has been made under the terms of the Budapest Treaty and that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent, would satisfy the deposit requirements. See 37 CFR 1.808. In addition the identifying information set forth in 37 CFR 1.809(d) should be added to the specification. See 37 CFR 1.803 - 37 CFR 1.809 for additional explanation of these requirements.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 42 and 49-76 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27, 29 and 30 of U.S. Patent No. 6,217,883 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent are drawn to a species of the instantly claimed genus of compositions comprising PCV2 and an additional pathogen. The species claimed in the patent anticipate the genus instantly claimed.

8. Claims 42-76 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 and 14-25 of U.S. Patent No. 6,953,581.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent are drawn to a species of the instantly claimed genus of compositions comprising PCV2 and an additional pathogen. The species claimed in the patent anticipate the genus instantly claimed.

### ***Conclusion***

9. No claim is allowed.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stacy B. Chen whose telephone number is 571-272-0896. The examiner can normally be reached on M-F (7:00-4:30). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James C. Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

A handwritten signature in black ink that reads "Stacy B. Chen". The signature is written in a cursive, flowing style.

Stacy B. Chen  
January 31, 2006